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No. 94-407

IN THE
Supreme Court of the United States
OCTOBER TERM, 1994

SGS-THOMSON MICROELECTRONICS, INC.,
Petitioner,

v.

INTERNATIONAL RECTIFIER CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* AND BRIEF *AMICUS CURIAE* OF THE AMERICAN BOARD OF TRIAL ADVOCATES IN SUPPORT OF PETITIONER

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MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*

The American Board of Trial Advocates (ABOTA) respectfully moves this Court for permission to file a brief as *amicus curiae* in support of the petition for a writ of certiorari filed by SGS-Thomson Microelectronics, Inc. in this case. Under Supreme Court Rule 37.2, ABOTA sought the consent of both parties to the filing of this brief. Petitioner has consented, but Respondent has not. Accordingly, ABOTA files this motion with the Court.

ABOTA respectfully submits that there are compelling reasons for the Court to grant this motion. ABOTA is

a national organization whose members include 3,900 trial lawyers, judges, and other public officials. ABOTA's members are vitally concerned with the preservation and improvement of the present civil justice system in the United States. A major purpose of the organization is to promote the fair and efficient administration of justice for the benefit of individual litigants and the general public.

ABOTA seeks leave to file this brief to bring to the Court's attention additional reasons for granting the petition. In the attached brief, ABOTA endorses, but does not duplicate, the arguments offered in the petition for a writ of certiorari.

ABOTA believes that its brief will serve to place the decision below in national perspective and will bring to the Court's attention additional authorities that bear on the far-reaching legal issue raised by this case and that indicate the invalidity of the appellate court's decision. This brief should assist the Court in its review and consideration of the petition. ABOTA therefore respectfully requests that this Court grant its motion for leave to file a brief as *amicus curiae* in support of the petition.

Respectfully submitted,

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QUESTION PRESENTED

After expressly reversing a district court's transfer of a case under section 1406(a) because the district court incorrectly ruled that it lacked personal jurisdiction over the defendant, can a court of appeals nevertheless remand the case to the improper transferee court—and thus in effect order a transfer under section 1404(a)—even though the court of appeals has considered only the transferee court's familiarity with the case and has ignored the other case-specific factors prescribed by Congress for consideration under section 1404(a) and even though the court of appeals has undertaken an improper *de novo* exercise of the discretionary function that Congress granted to district courts under that section?

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BRIEF *AMICUS CURIAE* OF THE AMERICAN BOARD OF TRIAL ADVOCATES IN SUPPORT OF PETITIONER

INTEREST OF *AMICUS CURIAE*

The American Board of Trial Advocates (ABOTA) is a national organization whose members include 3,900 trial lawyers, judges, and other public officials. As part of the eligibility requirements for membership, trial lawyers must have completed at least twenty civil jury trials. ABOTA and its members are vitally concerned with the improvement of the present civil justice system in the United States. They have a continuing interest in ensuring that the system remains fair and equitable to all parties. ABOTA strongly supports the fundamental principle that a plaintiff has a significant interest in choosing the venue of a lawsuit and that this choice should not be disturbed unless the court specifically considers both convenience and the interest of justice.

The decision below is of particular concern to ABOTA because it is a dangerous and far-reaching procedural decision by the Federal Circuit, which hears appeals from district courts throughout the entire nation. The effect of this decision will be to make erroneous transfer decisions absolutely unreviewable—thereby unfairly defeating plaintiffs' proper venue choices without regard for the traditional concerns of convenience and the interest of justice. ABOTA submits this brief because its members strongly believe that the Federal Circuit's decision will harm the fair and efficient administration of justice.

STATEMENT

In June 1991, SGS-Thomson sued International Rectifier Corporation (IR) in the Northern District of Texas, the location of SGS-Thomson's principal place of business. SGS-Thomson alleged that IR had infringed U.S. Patent No. 4,553,314. In August 1991, IR moved to dismiss for lack of personal jurisdiction or, in the alternative, to transfer the case to the Central District of California.

As SGS-Thomson's petition explains, SGS-Thomson opposed IR's motion because, based on IR's sales within the district, IR was subject to specific personal jurisdiction in the district, and venue in the Texas district court was proper. The Texas district court, however, ruled that it lacked personal jurisdiction over IR and ordered the case transferred to California, the location of IR's headquarters, under 28 U.S.C. § 1406(a).[1]

Soon after the Texas district court issued the transfer order, SGS-Thomson asked the court to certify the jurisdiction and venue issues for interlocutory appeal under 28 U.S.C. § 1292(b). When that request was denied, SGS-Thomson sought a writ of mandamus from the Federal Circuit. The Federal Circuit denied the writ, explaining that the case was not appropriate for mandamus —a remedy reserved for the most serious and critical ills

[1] Pet. App. 25a-26a.

—even though in a normal appeal, a court might find reversible error.[2]

After transfer to the Central District of California, SGS-Thomson amended its complaint to add infringement claims based on two additional patents. After pretrial discovery, the California district court granted two of IR's several motions for summary judgment, effectively ruling as a matter of law that IR was entitled to judgment on all claims brought by SGS-Thomson.[3] The district court also awarded IR over $2.1 million in attorneys' fees under 35 U.S.C. § 285, which permits fee awards only in "exceptional" cases brought under the patent laws.[4]

On appeal of the California district court's judgment, the Federal Circuit: (1) reversed the Texas district court's decision to transfer the case to California; (2) vacated the California district court's entry of two summary judgments in favor of IR; and (3) vacated the award of attorneys' fees for IR.[5] In reversing the transfer decision, the Federal Circuit specifically concluded that IR was subject to personal jurisdiction in the Northern District of Texas and that venue was properly placed there.[6]

Despite its explicit reversal of the Texas district court's transfer decision and despite SGS-Thomson's request that the case be remanded to the Northern District of Texas, the Federal Circuit remanded the case to the California district court—the court to which the case had been erroneously transferred in the first place.[7] Although the Federal Circuit actually *reversed* the transfer decision, it

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[2] Pet. App. 29a.

[3] Pet. App. 34a-42a; 45a-83a.

[4] Pet. App. 86a-104a.

[5] Pet. App. 2a, 18a, 19a-20a.

[6] Pet. App. 6a.

[7] Pet. App. 6a-7a.

still found the error *harmless*, resulting in the puzzling concept of reversible harmless error.

In remanding to the California district court, the court of appeals considered neither convenience nor the interest of justice. Instead, it based its remand decision entirely on its conclusion that "judicial economy would be served by transferring the case back to a court already familiar with the patents and technology at issue." [8] The court of appeals failed to explain why judicial familiarity was of paramount importance—or, indeed, was even relevant —in light of the fact that on remand, the patent infringement claims would be tried by a jury, and not by the judge.

In reaching its conclusion, the court of appeals has established that a case may be irretrievably transferred from a court with proper jurisdiction and venue, without any consideration at all for the convenience of parties and witnesses or the interest of justice. ABOTA respectfully submits that this Court should grant the petition to resolve the existing conflict in the circuits on this issue, to clarify federal appellate review of erroneous transfer decisions, and to safeguard individual litigants from the unjust effects of erroneous transfer decisions.

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[8] Pet. App. 6a-7a.

REASONS FOR GRANTING THE PETITION

I. The decision of the court of appeals denies plaintiffs the protections afforded by section 1404(a) and by federal caselaw interpreting that section.

Under section 1404(a), a district court can, in its discretion, transfer a case to another district, but only after considering the convenience of parties and witnesses and the interest of justice:

> For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.[9]

Near the time of this section's enactment, this Court explained that section 1404(a) "requires the court to determine that the transfer is necessary for convenience of the parties and witnesses, and further, that it is in the interest of justice to do so." [10] As this Court later explained, district courts must "adjudicate motions for transfer according to an 'individualized, case-by-case consideration of convenience and fairness.' A motion to transfer under § 1404(a) thus calls on the district court to weigh in the balance a number of case-specific factors." [11]

The legislative history of section 1404(a) provides that the subsection was drafted in accordance with the doctrine of *forum non conveniens*.[12] In exercising their discretion, then, district judges are not left wholly without

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[9] 28 U.S.C. § 1404(a); *see Stewart Organization, Inc. v. Ricoh Corp.*, 487 U.S. 22, 29, 108 S. Ct. 2239, 2244 (1988).

[10] *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 507, 67 S. Ct. 839, 842 (1947).

[11] *Ricoh Corp.*, 487 U.S. at 29, 108 S. Ct. at 2244 (quoting *Van Dusen v. Barrack*, 376 U.S. 612, 622, 84 S. Ct. 805, 812 (1964)).

[12] Revisor's Note, H.R. Rep. No. 308, 80th Cong., 1st Sess., A132 (1947); H.R. Rep. No. 2646, 79th Cong., 2d Sess., A127 (1946).

guidance—to order transfers based on their own individual notions of justice. Instead, Congress has instructed them to focus on the specific factors identified by this Court in articulating the doctrine of *forum non conveniens.*[13]

One factor of critical importance is the plaintiff's choice of forum: "unless the balance is strongly in favor of the defendant, the plaintiff's choice of forum should rarely be disturbed." [14] As one court has observed: "In reaching its decision, a court must give due regard to the factors traditionally associated with the doctrine of *forum non conveniens,* including the plaintiff's choice of forum under the limited options venue statutes offer the initiator of litigation." [15] In its analysis of convenience, the court "should act in response to considerations, apart from the court's own convenience, for rejecting a plaintiff's forum choice." [16]

As this Court has emphasized, transfer under section 1404(a) is not automatic: "one must remember that § 1404(a) does not provide for an automatic transfer of venue. The section, instead, permits a transfer only when convenient and 'in the interest of justice.' " [17] But under the Federal Circuit's approach, an entire class of

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[13] *See, e.g., Gulf Oil Corp. v. Gilbert,* 330 U.S. 501, 67 S. Ct. 839 (1947) (*forum non conveniens* factors); *Koster v. Lumbermens Mutual Casualty Co.,* 330 U.S. 518, 67 S. Ct. 828 (1947) (same); *see also Ricoh Corp.,* 487 U.S. at 29-31, 108 S. Ct. at 2244-45 (under section 1404(a), a district court must weigh the considerations prescribed by Congress).

[14] *Gulf Oil Corp.,* 330 U.S. at 508, 67 S. Ct. at 843; *see Koster,* 330 U.S. at 524, 67 S. Ct. at 831-32.

[15] *In re Scott,* 709 F.2d 717, 720 (D.C. Cir. 1983) (citing *Norwood v. Kirkpatrick,* 349 U.S. 29, 32, 75 S. Ct. 544, 546 (1955)).

[16] *Id.* at 721.

[17] *Ferens v. John Deere Co.,* 494 U.S. 516, 532, 110 S. Ct. 1274, 1284 (1990).

cases will call for automatic transfers under section 1404(a): whenever a court erroneously transfers a case under section 1406, based on an incorrect finding on jurisdiction or venue, the plaintiff will automatically be deprived of its chosen forum, without any consideration at all of the *forum non conveniens factors*, without any weighing of the convenience of parties and witnesses, and based solely on the familiarity that the improper transferee court will have inevitably gained with the case.

Even if the court of appeals could validly exercise its own discretion in place of that afforded district courts under section 1404(a)—a proposition that is highly doubtful, as discussed below—the court of appeals could not base its decision entirely on the sole factor of judicial familiarity with the case. The court of appeals could not simply abandon the case-specific weighing of considerations prescribed by Congress and this Court.[18] Indeed, in *Ricoh Corporation*, this Court flatly rejected the notion that a district court could find the single factor of a forum-selection clause dispositive of the analysis under section 1404(a):

> Congress has directed that multiple considerations govern transfer within the federal court system, and a state policy focusing on a single concern or a subset of the factors identified in § 1404(a) would defeat that command. Its application would impoverish the flexible and multifaceted analysis that Congress intended to govern motions to transfer within the federal system. The forum-selection clause . . . should receive neither dispositive consideration (as respondent might have it) nor no consideration (as Alabama law might have it), but rather the consideration for which Congress provided in § 1404(a).[19]

As in *Ricoh Corporation*, the Federal Circuit's myopic focus on the single concern of judicial familiarity defeats

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[18] *See Ricoh Corp.*, 487 U.S. at 29-31, 108 S. Ct. at 2244-45.

[19] *Id.* at 31, 108 S. Ct. at 2244-45.

the command of Congress that "multiple considerations govern transfer within the federal court system." [20]

If the Federal Circuit's analysis is allowed to stand, then any error by the initial forum in transferring a case will be effectively unreviewable. Even if the court of appeals explicitly reverses the transfer decision—as the Federal Circuit did in this case—the transferee court will always have gained some familiarity with the case, which, under the Federal Circuit's analysis, will be sufficient to justify leaving the case in the court to which it was wrongly transferred. This single factor—the judge's familiarity with the case—is not only insufficient, by itself, to justify a transfer but is also considered by some courts to be a factor that weighs against sending a case to that judge's court.[21] Even in a case scheduled for a bench trial, judicial familiarity would not be sufficient—without any consideration of the other factors—to justify a transfer. In a case scheduled for trial by jury, judicial familiarity, by itself, would be plainly insufficient as a basis for transfer.

Automatic transfers premised solely on reversible error by the district court unfairly deprive plaintiffs of the protections afforded by section 1404(a) and by the cases interpreting that section. Merely because the initial court reached an incorrect result on jurisdiction, a plaintiff should not be automatically denied its right to a jury trial in its home forum, where both jurisdiction and venue are proper. One court's unfortunate error should not strip a plaintiff of its right to have a district court—before transferring its case to a distant forum—carefully weigh the factors of convenience and the interest of justice.

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[20] *Id.*

[21] *Codex Corp. v. Milgo Electronic Corp.*, 553 F.2d 735, 739 (1st Cir.) (explaining that a judge who has already ruled on a patent's validity may have difficulty being impartial; "prior judicial experience in such a situation [is] more a negative than an affirmative reason for transfer"), *cert. denied*, 434 U.S. 860, 98 S. Ct. 185 (1977).

II. The decision of the court of appeals improperly authorizes an appellate court to effect a transfer under section 1404(a) in the first instance, without any action by the district court.

In remanding the case to the California district court, the court of appeals, based on the limited record before it, exercised its own judgment in place of the broad discretion afforded district courts in considering motions to transfer under section 1404(a). The Federal Circuit expressly reversed the decision of the Texas district court to transfer the case to California under section 1406(a). After declaring this transfer void, the appellate court's only option was to remand the case with instructions to return it to the Texas district court. Any other decision—including the Federal Circuit's decision to send the case to California—would be an improper *de novo* exercise of the appellate court's judgment.

As this Court has explained, section 1404(a) "is intended to place discretion *in the district court* to adjudicate motions for transfer."[22] In section 1404(a), Congress expressly limited the transfer authority to the district court: "a district court may transfer any civil action to any other district or division where it might have been brought."[23] In a case involving the related principles of *forum non conveniens*, this Court refused to allow a court of appeals to substitute its judgment for that of the district court:

> The *forum non conveniens* determination is committed to the sound discretion of the trial court. Here, the Court of Appeals expressly acknowledged that the standard of review was one of abuse of discretion. In examining the District Court's analysis of the public and private interests, however, the Court

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[22] *Ricoh Corp.*, 487 U.S. at 29, 108 S. Ct. at 2244 (emphasis added).

[23] 28 U.S.C. § 1404(a).

> of Appeals seems to have lost sight of this rule and substituted its own judgment for that of the District Court.[24]

In this case, the court of appeals went beyond substituting its judgment for that of the district court. After reversing the Texas court's decision to transfer under section 1406(a), the court of appeals refused to allow any district court even initially to consider a transfer under section 1404(a). Instead, by remanding the case to the California court, the court of appeals necessarily exercised its own judgment and, based on a single factor, effected a transfer from Texas to California.

Although in one case this Court allowed a court of appeals to issue a mandate ordering a transfer, that case involved the extraordinary circumstances of a district judge's refusal to comply with the appellate court's earlier mandate.[25] As this Court explained, "a federal appellate court does not ordinarily itself transfer a case to another district, but remands to the District Court for that purpose."[26] But in that case, the mandate was the only means of giving effect to the appellate court's decision; the court's extraordinary action "was taken as a result of extraordinary circumstances," which do not exist in a case such as this one.[27] In this case, no district court ever exercised its discretion to consider such a transfer under section 1404(a).

The transfer of a case under Federal Rule of Criminal Procedure 21(b) affords a district court similar broad

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[24] *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 257, 102 S. Ct. 252, 266-67 (1981).

[25] *Koehring Co. v. Hyde Construction Co.*, 382 U.S. 362, 364-65, 86 S. Ct. 522, 524 (1966); *see A. Olinick & Sons v. Dempster Bros., Inc.*, 365 F.2d 439, 448 n.5 (2d Cir. 1966) (Friendly, J., concurring) (discussing *Koehring*).

[26] *Koehring*, 382 U.S. at 364, 86 S. Ct. at 524.

[27] *Id.*

discretion to consider the same "interest of justice" factors as in a civil case.[28] In *Platt v. Minnesota Mining*, a criminal antitrust suit, this Court refused to allow a court of appeals to usurp the statutory power granted to the district court to order such a transfer:

> The District Court's use of an inappropriate factor did not empower the Court of Appeals to order the transfer. The function of the Court of Appeals in this case was to determine the appropriate criteria and then leave their application to the trial judge on remand. . . . Here, however, the Court of Appeals undertook a *de novo* examination of the record and itself exercised the discretion function which the rule commits to the trial judge.[29]

As Judge Friendly later remarked, "the Court was concerned with the distribution of power, not with judicial etiquette."[30] In this case, instead of leaving the application of the appropriate criteria to the original district court, as it should have, the court of appeals usurped the power of the district court and unfairly deprived SGS-Thomson of its venue choice and of its statutory right to a weighing of factors under section 1404(a).

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[28] *See Platt v. Minnesota Mining & Mfg. Co.*, 376 U.S. 240, 241, 84 S. Ct. 769, 770 (1964).

[29] *Id.* at 244-45, 84 S. Ct. at 772.

[30] *A. Olinick & Sons v. Dempster Bros., Inc.*, 365 F.2d 439, 448 (2d Cir. 1966) (Friendly, J., concurring).

CONCLUSION

The Federal Circuit's decision undermines the statutory protections afforded plaintiffs under section 1404(a) and improperly allows an appellate court to usurp the discretion Congress committed to district courts under that section. The Federal Circuit's ruling interferes with the rights of litigants and improperly changes the distribution of authority within the federal court system. For these reasons and for the reasons stated in the petition, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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